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| 09/690,284      | 10/17/2000  | Robert J. Johnson    | F-147               | 2197             |

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| EXAMINER |
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LEE, SEUNG H

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| ART UNIT | PAPER NUMBER |
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2876

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/690,284

Applicant(s)

JOHNSON ET AL.

Examiner

Seung H Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 February 2003 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 6, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,244,763, of the record) in view of Block (US 6,010,156, of the record), Wolfram (US 5,051,565), and Petkovsek (US 5,697,648, cited by applicant).

Miller teaches the method for printing an indicia on a label in a system including reading a label configuration file (10, 40, 60) (see Fig. 1 - 3, and 5), selecting an amount of labels to be printed, printing the amount of labels (94) using two dimensional barcode corresponding to the United States Postal Service (USPS) Indicia-Based Information Program (IBIP) (see Fig. 5; col. 1, lines 18 - 33; col. 7, lines 5 - 10),

However, Miller fails to teach or fairly suggest that the selecting a label stock, reading a definition file associated with the selected label stock, and tagging the label pair with a unique identifying mark (i.e., hash line) in a predetermined inconspicuous area of the label.

Block teaches the label pair comprising a destination address label having a destination address (313) and a corresponding an indicia label or delivery point barcode (315) is printed, coding identifier (319) contains USPS readable data in which produced the label which a plurality of tick hashing line, printing labels based on proper postage amount for items to be mailed (see Fig. 3A; col. 1, lines 6-25; col. 4, lines 21-57; col. 5, lines 6-21). And Wolfram teaches duplicated labels (19) in which the labels are attached to a boarding pass (14A) and baggage tags (13) (see Fig. 2; col. 3, lines 46-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Block and Wolfram to the teachings of the Miller in order to identify indicia using the USPS standard facing identification mark. Moreover, such modification would improve readability of the label since the destination address label includes the human readable address for operator(s) and bar-coded address for scanning device. Furthermore, such modification would provide easier sorting means for sorting mail piece based on the value/number of hash lines, that is, hash lines can be determined to delivery location (i.e., payment department, customer service department, product inquiry department) automatically using a OCR reader and/or sorting personnel, and therefore an obvious expedient. Although, Miller as modified by Block and Wolfram fails to particularly teach the label configuration file is

indicative of one or more label stocks and selecting a label stock for printing indicia on the label, the system of Miller/Block/Wolfram obviously includes a software/template to choose/select appropriate label layout among various layouts (Fig. 1 to 3) for proper printout of the label indicia to further accommodate the size of the box or the size of the item to be placed thereupon (i.e., the system would not print-out a label which is twice as big as the item/box to attach the label thereon, etc), and therefore an obvious expedient.

However, Miller/Block/Wolfram fails to particularly teach the identifying mark is human discernable.

Petkovsek teaches a mailing assembly (10) on a single sheet wherein the mailing assembly comprising a label (12) and a return post card (13) having a identical identification number (16) on both label and return post card (see Fig. 1; col. 4, lines 4-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Petkovsek to the teachings of Miller/Block/Wolfram in order to provide an alternative means for identifying information/data of the particular article/label manually using human discernable code in case when the code is corrupted and/or the reader for reading the code is malfunctioning, and therefore an obvious expedient.

4. Claims 2, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as modified by Block, Wolfram, and Petkovsek as applied to claim 1 above,

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and further in view of Fougere et al. (US 4,743,747, of the record)(hereinafter referred to as 'Fougere').

The teachings of Miller/Block/Wolfram/Petkovsek have been discussed above.

Although, Miller/Block/Wolfram/Petkovsek teach the printing method of label, they fail to teach or fairly suggest that the barcode is encrypted and the coding identifier is an alphanumeric character.

Fougere teaches the encrypted alphanumeric character (42) or the barcode (42A) for retrieving information (i.e., postage, address, etc.) (see Figs. 2 and 3; col. 4, line 53- col. 5, line 23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fougere to the teachings of Miller/Block/Wolfram/Petkovsek in order to provide an improved security means by encrypting of the destination barcode for preventing an authorized personnel from knowing the destination address. Moreover, such modification (i.e., alphanumeric character as a coding identifier) would provide easier means for tracking the mail since the mail is scanned into the system at every major transaction center using unique tracking code or identification number. Furthermore, such modification (i.e., alphanumeric character as a coding identifier) would provide an alternative method of reading the identification of the mail due to the fact that when the reading machine is not working properly, the alphanumeric coding identifier or tracking code would provide proper identification of mail, and therefore an obvious expedient.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as modified by Block, Wolfram, and Petkovsek as applied to claim 1 above, and further in view of Bone, Jr. (US 5,270,522, of the record).

The teachings of Miller/Block/Wolfram/Petkovsek have been discussed above.

Although, Miller/Block/Wolfram/Petkovsek teach the printing method of label, they fail to teach or fairly suggest that the label pair includes a color-coding of the label.

Bone, Jr. teaches the barcode label and/or human readable characters are printed in color (see Fig. 12; col. 6, lines 1-10, col. 13, lines 28-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the color printing of indicia as taught by Bone, Jr. to the method of printing indicia on the label as taught by Miller/Block/Wolfram/Petkovsek in order to have a better recognition/verification of the identifying mark under a different light conditions (i.e., dark and/or bright lighting conditions). Furthermore, such modification (i.e., printing indicia in color) would have been an obvious design variation, failing to provide any unexpected results, well within the ordinary skill in the art.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as modified by Block, Wolfram, and Petkovsek as applied to claim 1 above, and further in view of Klippert (DE 32 33 005, of the record).

The teachings of Miller/Block/Wolfram/Petkovsek have been discussed above.

Although, Miller/Block/Wolfram/Petkovsek teach the printing method of label, they fail to teach or fairly suggest that the coding identifier is a watermark.

Klippert teaches the watermark is imprinted on the postage stamp (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the identifying mark such as watermark as taught by Klippert to the teachings of the Miller/Block/Wolfram/Petkovsek in order to provide an improved and an enhanced means for validating/authenticating the postage stamp by examining the watermark on the stamp. Furthermore, such modification would prevent an unauthorized copy by providing a certain phrase and/or word (e.g., VOID, Copied Document, etc.) when the printed label has been copied, and therefore an obvious expedient.

### ***Response to Arguments***

7. Applicant's arguments filed 21 January 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that "*A facing mark is constant and not useful for distinguishing different label pairs*" (see page 4, line 21+), the Examiner interpret the two-dimensional barcode (319) as a coding identifier wherein the barcode is comprising a plurality of thick and thin hash lines in which the barcode is unique for identifying the each article/label as discussed in paragraph 3 above.

In response to the applicant's argument that "*.....the label pair with a unique identifying mark that is human discernable to allow to a user to match said label pair*" (see page 4, line 23+), the Examiner respectfully provide a Petkovsek reference wherein Petkovsek teaches the unique alphanumeric identification numbers are



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attached on both label and the return post card wherein the identification numbers are human discernable in order to operator(s) and/or user(s) can read as discussed in paragraph 3 above.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Sansone et al [US 6,142,380], Sansone et al [US 5,292,008], Berson [US 5,929,415], Dolan et al [US 5,806,421], Fabel [US 6,209,920] disclose a postal indicia and printing the same.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35*

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*U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
Seung H. Lee  
Art Unit 2876  
April 30 2003

  
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